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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,529	03/29/2004	Yuval Arie Tresser		1178

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INVENTION SOLUTION
C/O YUVAL TRESSER
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NEW YORK, NY 10025

EXAMINER

MOSSER, ROBERT E

ART UNIT	PAPER NUMBER
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3714

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/810,529	Applicant(s) TRESSER ET AL.	
	Examiner Robert Mosser	Art Unit 3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-70 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-40, 44-55, 57, 62-70 is/are rejected.
- 7) ☒ Claim(s) 13, 41-43, 56 and 58-61 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART

While features of an apparatus may be recited either structurally or functionally, claims directed to an **apparatus must be distinguished from the prior art in terms of structure rather than function**. A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. (See *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987), *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997), *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971), *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959), and MPEP 2114).

The instant case is replete with issues of intended use. If the Applicant intends for these limitations to be considered as possible distinguishing features of their claimed invention they must be appropriately presented within the confines of a method type claims. For the purposes of this action these limitations have been correlated to the prior art of record where available for the purposes of further prosecution.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **5, 20-23, 35-36, 39-40, 46-47, and 49-51** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims **5, 20-23, 35-36, 39-40, 46-47, and 49-51** the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **1-3, 14-32, 37-40, 44-55, 57, and 62-70** are rejected under 35 U.S.C. 102(b) as being anticipated by Sity et al (US 6,331,145).

Claims **1-3, 62-65**: Sity teaches an electronic die including:

A sensor for detecting the position of the die and orientation of the die faces utilizing induction coil, capacitive mechanical and optical (including photodiode and photo-transistor) sensor technology (Col 4:40-50);

A storage device including for storing the results detected by the sensors;

A transmission device for transmitting the results detected by the sensors and stored in the storage device and utilizing radio frequency communication (Col 4:20-24);

An identification portion for transmission source identification (Col 5:45-50);

Claims **14, 19**: Sity teaches the electronic die as further utilizing mechanical sensors to determine the orientation of the die. As mechanical system are subject to gravity at least part of the detection by the mechanical sensor would be subject to and influenced by gravity (Col 4:40-50);

Claims **15**: Sity teaches the electronic die as being powered through induced current, or photoelectric material (Col 6:9-26).

Claims **16-18**: Sity teaches the electronic die that inherently does not contain any moving parts when the die employs optical sensors (Col 4:34-44) as the die would be devoid of any mechanical components.

Claims **20-23**: Sity teaches the electronic die that contains an electronic memory for storing data (Element 22). Additional limitations directed to the operation of the memory are intended use type limitations and accordingly are afforded limited patentable weight.

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Claims **24-27, 29-32**: Sity teaches the electronic die that allows the judgment of the correctness and fairness of the die results (Elm 222, 224 and Figure 5).

Claim **28**: Sity teaches the use of encryption to protect communication from the die (Col 2:58-64).

Claim **37-38**: Sity teaches the inclusion of a six sided die including the enumeration of the respective side with values ranging from 1 to 6 (Figure 1, Col 4:1-9).

Claim **39-40**: Sity teaches that the number of faces on a die can be different then 6 (Col 4:30-33).

Claim **44**: Sity teaches that the timing of the message transmitted to the host is determined by the die (Figure 5).

Claims **45-48**: Sity teaches a communication link between the die and a computer including a display to enable the play of a video game (Col 1:35-43).

Claims **49-51**: The listed claims present limitations directed to the intended use of an apparatus and accordingly fail to further define the claimed invention.

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Claims **52-53** Sity teaches determining the orientation of the die through determining which face of the die is facing down (Col 4:33-39).

Claims **54-55, 57** Sity teaches determining the orientation of the die through the use optical of light detection or equivalent thereto photoelectric cells (Col 4:42-44).

Claims **66-70** Sity teaches tracking the die outcomes, check for the validity of the die data, and remove the data determined to be fraudulent (Figure 5).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **4-12** and **33-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over by Sity et al (US 6,331,145).

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Claims 4-5, and 11: Sity teaches the electronic die as described above including the incorporation of RF communications, Sity however is silent regarding the particular RF communications protocol utilized for RF communication. The Examiner gives official notice that the RF communication protocols of Bluetooth, 802.11, and ad-hoc are extremely old and well known communications protocol at the time of claimed invention. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated known communication protocols into the RF communication system of Sity because such a combination represents a mere combination of known elements through conventional manner to yields predictable and expected results.

Claims 6, 8, and 12: Sity teaches the inclusion of one or more batteries and the inclusion photoelectric cells (Col 6:24-27) however, Sity is arguably silent regarding combining both of these power methods in a singular embodiment of the invention. It would have been obvious to one of ordinary skill in the art at the time of invention to have combined the known power device of Sity to provide a redundant power supply.

Sity additionally teaches the need to replace batteries (Col 6:20-23).

Claims 7, and 9: Sity teaches the inclusion of a no battery embodiment of his invention including the receipt on operating energy through transmitted radio waves (Col 6:9-22) however is silent regarding the incorporation of a capacitor and a transducer. The Examiner gives official notice however that the inclusion of a transducer and a capacitor however is extremely old and well known in the art for receiving driving electrical power

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through wireless transmission. Accordingly it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated a capacitor and transducer into the no battery embodiment of the invention of Sity in order to employ known wireless power transfer methods and apparatus of Sity to you expected and predictable results.

Claim 10: Refers to the intended use of the device and fails to further modify the structure as previously defined. Accordingly the manner of intended use cannot provide a basis for a patentable distinction of the claimed invention and the prior art.

Claims 33-36: Sity teaches the device as set forth above however is silent regarding the shape of the dice corners as claimed. The Examiner gives official notice that the use of rounded and cubical corners on dice is extremely old and well known in the art. It would have been obvious to one of ordinary skill in the art to form the corners of the die as either rounded or cubic in order to conform with convention die shapes. Claim limitations directed to the particular game examples including craps and 421 are directed to intended use. Limitations of apparatus type claims must demonstrate a distinguish over the prior art through structure and not the use of said structure.

Allowable Subject Matter

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Claims 13, 41-43, 56, and 58-61 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/RM/
September 24th, 2007


ROBERT E. PEZZUTO
SUPERVISORY PRIMARY EXAMINER